

REMARKS

Claims 11-18 are now pending and stand rejected in the application. New claims 19 and 20 are added. Upon entry of the amendments, claims 11-20 remain pending.

Support for the new claims is found in the specification as originally filed. Applicants respectfully request entry of the amendments.

ADVISORY ACTION

Applicants thank the Examiner for the Advisory Action of April 3. The Examiner stated the amendments would be entered, but maintained that they would stay rejected under the art of record. Applicants offer two new claims in this preliminary amendment, and wish to offer the following remarks, consistent with their positions taken in earlier prosecution and in the After Final Amendment.

INTERVIEW WITH EXAMINER MITCHELL

Applicants request the favor an in person interview with Examiner Mitchell, preferably prior to consideration of this amendment.

REJECTION UNDER 35 U.S.C. § 103

Claims 11-18 are rejected under 35 U.S.C. § 103(a) as obvious over the Lutkus reference (U.S. Patent No. 6,224,311) in view of the Whitford Paper ("11 Reasons Why Chromium-free Xylan® 5230 is specified by DaimlerChrysler, Ford and General Motors"). Applicant respectfully traverses the rejection for the reasons given in their earlier replies. In addition, Applicant respectfully requests consideration of the following additional remarks.

As a preliminary matter, Applicants respectfully wish to clarify that they do not argue that “an advantage that would necessarily exist is somehow patentable”, to quote the words of the Advisory Action. Rather, they argue that they have discovered (and are claiming) surprising benefits in a novel composition, which makes their invention as a whole patentable under the statute, the precedent of the CAFC, and the directions of the Commissioner in the MPEP. With these thoughts in mind, Applicants respectfully request reconsideration in light of the of the following comments.

In response to an earlier rejection on the basis of the Lutkus reference and the Whitford paper, Applicant amended claim 11 to its present state, reciting that the claimed insert performed better in a prevailing torque test using tangless inserts than an insert coated with a chromium-containing fluoropolymer composition.

Applicant respectfully submits the added limitation is entitled to patentable weight because it is drawn to a structure and not just to recitation of an advantage. Performance in a torque test depends on the nature of the coating. If a torque test result is different for a claimed structure, the claimed structure must necessarily be different. Applicant has discovered a difference in structure as regards the claimed inserts, and has claimed that difference in a manner supported by his specification.

Applicant further submits that the claimed invention as a whole is non-obvious in view of the cited art. In taking the counter position, the Office Action at section 5 cites *In re Obiaya* for the proposition that

“[recognition of] another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious”. (Emphasis added)

As indicated by the emphasized parts of the quote from Obiaya, the rule is not absolute – the advantage must flow naturally, and the differences must otherwise be obvious.

There is no teaching in the cited references that the advantage (i.e., the difference in structure leading to improved torque tests) would naturally flow. The Whitford paper states that in certain fastener systems chromate free systems are preferred because they lack chromium; this is not a teaching that, as applied to inserts, the chromate free coatings would give an unexpectedly different structure or the unexpected benefit of better performance in a torque test. Any feature of chromium free coatings that would give rise to the structural difference recited in amended claim 11 was completely unknown and untaught by the references.

Because the claimed feature was unknown, it cannot be said the advantage would “naturally flow” from the references. Applicant respectfully submits that even if the effect is inherent, it was not known and can not be the basis of a rejection under § 103. See *In re Spormann* 150 USPQ 449, 452 (CCPA 1966) (“... the inherency of an advantage and its obviousness are different questions. That which is inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.”)¹. See also *In re Rijkaert* 28 USPQ2d 1955 (Fed. Cir. 1993), cited at MPEP §2141.03 V. (“obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a feature is later established”).

Applicant grants that there is a seeming tension between Obiaya and cases like Spormann. The former states (with some qualifications) that inherent properties do not make an invention patentable, while the latter seems to take the position that unknown features can be the basis of patentability, even if they are inherent. Applicants

respectfully submit that in the current case the tension is resolved in their favor based on consideration of the patent statute and its “invention as a whole” requirement..

35 USC § 103 states that a novel invention is patentable unless

“ the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art ... ” Emphasis added.

The subject matter as a whole inquiry includes subject matter literally recited in the claim, and also to those properties which are inherent in the subject matter and are disclosed in the specification. *In re Antonie* 195 USPQ 6, 8 (CCPA 1977). See also MPEP §2141.03. That is, the current invention as a whole includes the recited feature that the coating has an unexpected structure that leads to better performance of the coated insert in a torque test. Because the feature was completely unknown in the prior art, it cannot be said that the subject matter as a whole would have been obvious.

Applicants respectfully maintain their position that the combined references do not teach or suggest every element of the amended claims. Specifically, the independent claims 11 and 14 were amended earlier to recite that the inserts coated with a chromate-free polymer composition perform better in a torque test when compared with inserts coated with fluoropolymer compositions that do contain chromate. This feature of the invention is fully disclosed, for example at paragraph 29 on page 8. The cited references do not disclose or suggest this limitation of the amended claims. Accordingly, Applicants respectfully request that the rejection as applied to the amended claims be withdrawn.

¹ A copy of *In re Spormann* was attached to the After Final Amendment

New Claims

New claims 19 and 20 depend from claims 14 and 11, respectively. They recite that the insert is tangless. Applicants respectfully submit they are patentable for the reasons discussed above and for the further reason that the cited references do not suggest tangless inserts having those properties.

CONCLUSION

On the basis of the above, Applicants believe that claims 11-20 are in an allowable condition. Further and favorable consideration is earnestly solicited. The Examiner is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

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